

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-10 are pending in the application, with 1 and 10 being the independent claims. Claims 6 and 7 are sought to be amended to provide an even more clear antecedent basis, not to avoid prior art. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 103

In paragraph 2 of the Office Action, claims 1-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,467,403 to Fishbine *et al.* (hereinafter Fishbine) in view of U.S. Patent No. 6,154,010 to Geiger (hereinafter Geiger). Applicants respectfully traverse the rejection.

Technical differences exist between Fishbine and the present invention. Furthermore, Geiger cannot be used to provide the missing teachings of Fishbine.

Fishbine appears to describe a portable fingerprint scanning apparatus. However, Fishbine does not teach or suggest a data and power communication interface that couples data between a fingerprint scanner and a docking station, and provides power to charge a rechargeable power supply of the fingerprint scanner, where a dedicated plug for

recharging the power supply separate from the interface can be avoided, as recited in claim 1. This is supported by paragraph 3 of the Office Action, which states, "Fishbine does not expressly disclose, whereby, a dedicated plug for recharging a power supply separate from a data interface can be avoided."

Geiger relates to a mobile computer. Geiger does not teach or suggest that a dedicated plug for recharging the power supply separate from the data and power interface can be avoided for a fingerprint scanner. Thus, for at least this reason, Geiger alone does not teach or suggest all the features of claim 1. Furthermore, as discussed below, Geiger cannot even be combined with Fishbine to provide teachings missing from Fishbine.

As stated in M.P.E.P. § 2142, to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Applicants respectfully assert that no such suggestion or motivation is present. Therefore, Applicants assert that a *prima facie* case of obviousness has not been established.

As further stated in the M.P.E.P.:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. . . . Although a prior art device "may be capable of being modified to run the way the apparatus is claimed,

there must be a suggestion or motivation in the references to do so." 916

F.2d at 682.

M.P.E.P. § 2143.01, page 2100-126 (emphasis added). The Office Action states on page 3 that "[i]t would have been obvious to one ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because they are both directed to the recharging and interfacing of a device." Applicants respectfully disagree that the cited references are "directed" to the recharging and interfacing of a device. For example, Fishbine is titled "Portable Fingerprint Scanning Apparatus for Identification Verification," which does not indicate that Fishbine is directed to recharging and interfacing a device. Furthermore, in the statement made in the Office Action, the Examiner has pointed to no particular suggestion or motivation in the references themselves for the combination. Thus, Applicants assert that no suggestion or motivation in the references for their combination has been provided.

Furthermore, contrary to the assertion of the Examiner, Geiger and Fishbine are sufficiently unrelated, and therefore, no suggestion or motivation exists in the knowledge generally available to one of ordinary skill in the art for their combination. Therefore, their teachings are not combinable.

For example, structurally, Geiger relates to a mobile computer, while Fishbine relates to a portable fingerprint scanning apparatus. The mobile computer of Geiger does not include a fingerprint scanner. The form factors of the mobile computer of Geiger and the portable fingerprint scanner apparatus of Fishbine are different. For example, compare unit 10 shown in FIG. 5 of Fishbine to mobile computer 30 shown in FIG. 3 of

Geiger (e.g., different shapes, display types, input mediums, etc.). Such different form factors lead to different data and power communication interface requirements.

Furthermore, functionally, the mobile computer of Geiger relates to computing, while the portable fingerprint scanner apparatus of Fishbine relates to fingerprint scanning. The mobile computer of Geiger does not include a fingerprint scanner, and therefore does not relate to portable fingerprint scanning, as does Fishbine. The portable fingerprint scanner of Fishbine is not a computer, and cannot be used as a computer. Furthermore, any processing performed by the mobile computer of Geiger and the fingerprint scanner of Fishbine is very different. The mobile computer of Geiger performs general application processing. Any processing performed by the fingerprint scanner of Fishbine is related to fingerprint scanning.

Still further, the mobile computer of Geiger and fingerprint scanner of Fishbine are used in distinctly different environments. As stated in column 3, lines 44-50, of Fishbine, "[i]n the preferred embodiment, base unit 8 is mounted in a mobile unit such as a patrol car. Camera 20 generates a photographic image, or 'mug shot', of the person being fingerprinted. Camera 20 can also be used to capture a picture of the scene being investigated." Fishbine does not teach or suggest such a use for the mobile computer of Geiger, and in fact, the mobile computer of Geiger would not be capable of such use. Furthermore, these different use environments lead to additional different data and power communication interface requirements. For example, the mobile fingerprint scanner of Fishbine must interface with a base unit in a patrol car.

In light of at least the different structures, functions, and use environments taught by Geiger and Fishbine, no suggestion or motivation exists in the knowledge generally

available to one of ordinary skill in the art for their combination. Therefore, claim 1 is patentable over Geiger and Fishbine.

Further technical differences exist between the claimed invention, and Fishbine and Geiger. For example, claim 6 recites that the "data and power communication interface comprises a universal serial bus (USB)." Claim 7 recites that the "data and power communication interface comprises an IEEE1394 compatible interface." Neither of Fishbine and Geiger teach or suggest a universal serial bus (USB) or an IEEE1394 compatible interface. Such standard interfaces have not been previously disclosed in a portable fingerprint scanning context, as in the present invention, and provide numerous advantages, including increased compatibility and higher fingerprint data transfer speeds.

As described above, neither of Fishbine and Geiger teach or suggest that a dedicated plug for recharging the power supply separate from the data and power interface can be avoided for a fingerprint scanner, as recited in claim 1 of the claimed invention. Furthermore, Fishbine and Geiger are non-combinable because no suggestion or motivation for the combination has been established. For at least these reasons, independent claim 1 is patentable over Fishbine and Geiger. Furthermore, for at least these reasons, and further in view of their respective features, independent claim 10 is likewise patentable over Fishbine and Geiger. Claims 2-9, which depend from independent claim 1, are likewise patentable over the cited references for at least the reasons provided above, and further in view of their own features. Accordingly, Applicants respectfully request that the rejection of claims 1-10 be reconsidered and withdrawn.

Other Matters

Applicants acknowledge with appreciation the Examiner's consideration of the documents listed on Forms 1449 filed with Information Disclosure Statements (IDSs) at the USPTO on June 29, 2001, and January 6, 2003. Applicants note that an IDS was also filed at the USPTO on October 10, 2000, in the present application, having a Form 1449 listing four documents. Accordingly, Applicants respectfully request that the Examiner provide an indication of his consideration of the documents of the October 10, 2000, IDS by appropriately initialing the Form 1449, and returning a copy of the initialed Form 1449 to Applicants.

Conclusion

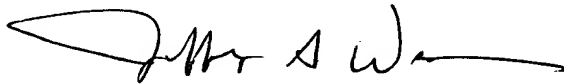
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will

expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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